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James Rist

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EXAMINER

HOEL, MATTHEW D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/020,484	Applicant(s) RIST, JAMES	
	Examiner Matthew D. Hoel	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25,27,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25,27,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 19 to 23, 25, 27, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand (U.S. pre-grant publication 2002/0125627 A1) in view of Winters (provisional application 60/337,409, published as 7,014,029 and 2003/0111316, entered as NPL 06-07-2007) and Paulsen, et al. (U.S. patent 7,390,257 B2).

1. As to Claim 19: '627 discloses all of the limitations of Claim 19, but lacks specificity as to a repeating 1, 2, 3, 2 lighting sequence and counters for detecting a threshold rate of false bills. '627 teaches a gaming machine comprising a bill acceptor configured to receive bills tendered (Abst.), the bill acceptor comprising a sensor configured to evaluate each received bill and to output a signal indicative of one an

acceptance and a rejection of the received bill (Para. 21). '627's bill acceptor bezel visually indicates by lights acceptance of (denominations of rejected bill indicated 40, 42, 44, 46, 48, & 50, Fig. 3, Paras. 7 & 21) and rejection of a bill (52, Fig. 3, Para. 21). '627 in the background description of the prior art teaches an annunciator having an array of illuminating elements configured to be illuminated in first, second, and third illuminating patterns, the first illuminating pattern being different from the second illuminating pattern, the second illuminating pattern being different from the third illuminating pattern, and the first pattern being different from the third illuminating pattern (Para. 4, runway sequence pointing to place bill into slot, disclosed without further elaboration; sequenced runway pattern known in the art as having different respective and sequentially flashed first, second, and third patterns, as evidenced by Chase, 4,291,294 A, Fig. 3, 22, 5:59-6:10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the sequential first, second, and third patterns of '627's background to '627's main embodiment. Fig. 3 of '627 indicates pointers indicating the direction in which the bill is intended to be inserted into the bill slot. The arrows are arranged in rows pointing toward the slot. These rows of arrows could be easily modified by one of ordinary skill in the art to flash in the sequential runway manner indicated. This modification would have the advantage of clearly indicating to the player the direction in which bills are to be inserted into the slot.

'409, however, teaches a controller having a first counter and a second counter, configured to increment the first counter on each occurrence of an acceptance signal, and to increment the second counter on each occurrence of a rejection signal (counter

determines number of real coins, "REAL" memory location or "counter" incremented, and number of false coins, "FAUX" memory location or "counter" incremented, Para. 19, Page 5). '409 determines a bill acceptance rate using the first and second counters and to activate the annunciator when the bill acceptance rate falls below a value (102, 104, 106, 108, Fig. 1, signal sent to casino staff, last para. of Page 7 & first para. of Page 8). The 103 combination of '627 and '409 would thus activate an annunciator when the computed bill acceptance rate falls below a predetermined value. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the first and second counters and threshold of '409 to the gaming device of '627. '627 is able to count the number and type of each note passing through the acceptor (Para. 27) and determines the authenticity of each note (Para. 16), so '627 has the counters necessary to implement the counting of '409. '627 has reject and counterfeit indicators (Para. 21) which fill an analogous role to the personnel notification of '409 (Page 6). '627 analogously monitors the gaming device over a network (Para. 14) like '409 (Page 7, last para. and Page 8, first para.). The examiner notes that while '409 detects fraudulent coins and '627 detects fraudulent bills, the threshold rates and counters are usable in either type of detection, as the rejection threshold rates and counters do not pertain to physical characteristics of bills and coins. The advantage of this combination would be to avoid a false alarm each time there is a worn or old bill, and to adjust the percentage of rejected bills to protect the house's margin and at the same time not inconvenience players with false alarms ('409, Para. 9, Page 3).

'257, however, sequentially energizes the array of illuminating elements in the first, second, third, and second patterns sequentially (up and down pattern, 8:8-15, '257 in its main embodiment has three stages, Fig. 3, 7:19-27, so, for example, stage 411 then 412 then 413 then 412, repeating over and over would be lit). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the repeated first, second, third, and second patterns of '257 to the combination of '627 and '409. '257 teaches that the module may have any shape (3:63-66), and so could easily be modified to the bezel shape of '627. '257 is used to indicate the casino personnel that the gaming machine needs to be serviced (3:27-30, 9:57-59), but also what type of servicing is needed (10:16-19). The examiner notes that the repeated 1, 2, 3, 2 pattern of '257 has no particular utility, unlike the repeated 1, 2, 3 pattern of '627 which moves in the direction the bill is to be put into the slot as an indication to the player. Thus, the innocuous repeated 1, 2, 3, 2 would not tip off a cheating player that casino personnel have been notified that the false (or possibly just worn-out) bills have exceeded a tolerable rate; such an intent of not interrupting game play by the bezel is intended by '627 (Para. 9). This modification would thus have the advantage of notifying casino personnel that service is needed without unduly interrupting game play.

2. As to Claim 27: '627 teaches a method of operating a bill acceptor of a gaming machine, the gaming machine including an annunciator represented by an array of illuminating elements (Abst., Fig. 3, Para. 21). '627 receives a bill at the bill acceptor and senses at least one characteristic of the received bill (Paras. 17 & 21), and generating one of an acceptance signal and a rejection signal using the at least one

sensed characteristic (Paras. 17 & 21). '409 increments a respective one of an acceptance counter and a rejection counter based on the respective acceptance and rejection signals, and determines a bill acceptance rate of the bill acceptor based on respective cumulated of the acceptance and rejection counters (Fig. 1, counter determines number of real coins, "REAL" memory location or "counter" incremented, and number of false coins, "FAUX" memory location or "counter" incremented, Para. 19, Page 5). '627 automatically, repetitively, and sequentially activating a plurality of illuminating elements in first, second, and third patterns, the first illuminating pattern being different from the second illuminating pattern, the second illuminating pattern being different from the third illuminating pattern, and the first illuminating pattern being different from the third illuminating pattern (Para. 4). '257 automatically, repetitively, and sequentially activating the plurality of illuminating elements in the first, second, third, and second patterns (up and down pattern, 8:8-15, '257 in its main embodiment has three stages, Fig. 3, 7:19-27, so, for example, stage 411 then 412 then 413 then 412, repeating over and over would be lit). '627 has automatic separate indication when the bills are either accepted or rejected (Para. 21, Fig. 3).

3. As to Claim 20: '627 teaches the annunciator being arranged in an area of the bill acceptor that receives bills and is visible external of the gaming machine (Fig. 3).

4. As to Claims 21 to 23: These claims pertain to the bill acceptor having rejection rates of 10%, 20%, and 30%. '409 discloses the value at 70% (first para., page 7) as in Claim 23. The applicant has not stated the purpose of the 80 and 90% rejection rates of Claims 22 and 21. Do they have to do with the weight or texture of the bills' paper, or

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the color of the bills' ink, or the authenticity of the patterns on the bills, or the amount of tearing of the bills? The applicant also does not say whether these rejection rates pertain to specific nations' currencies or specific denominations or if they pertain to visual, infrared, or magnetic, etc., sensors. The applicant merely states on Page 2 of the specification that these limits can be set by the operator. They are presumably set empirically without any analysis as to why they should be set at these rejection rates. It appears that '409, or the applicant's invention would perform equally well for their intended purposes when set to these rejection rates. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have set the rejection rates of '487 to 10%, 20%, or 30% as these rejection rates are mere design choices that have no patentable weight over '409's specification.

5. As to Claim 25: Winters ('409), however, on Pages 3 and 4 discloses a fraudulent transaction of a person feeding fraudulent coins into the machine, resulting in a higher rejection rate, and the rejection rate being reported over the network via phone lines.

6. As to Claims 30 and 31: '627 teaches the first, second, and third illuminating patterns being configured to create an impression feeding towards the bill acceptor (Para. 4).

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over '627, '409, and '257 in view of Bell (U.S. 6,722,487 B1).

1. As to Claim 24: The combination of '627, '409, and '257 discloses all of the elements of Claim 24, but lacks specificity as to updating the ratio upon each deposit of

a bill. '487, however, teaches in 3:48-61 that the bill acceptor is responsive to each subsequent fraudulent attempt and that each subsequent attempt triggers the restricted acceptance range, essentially resetting the number of times until the normal restricted range each time there is a subsequent fraudulent attempt during the countdown period of the restricted acceptance range. See, for example, '487, 3:19-47, when the acceptance rate falls below a threshold, indicating either a large number of fraudulent or bad bills, '487 uses a narrower set of acceptance criteria, resulting in fewer rejections, namely, fewer worn or rejected bills getting into the machine, the narrower criteria are thus used to accept or reject bills. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the updated acceptance rate after each insertion of '487 to the combination of '627, '409, and '257. '627 only determines the threshold rate of accepted bills on a periodic basis, not every time a bill is inserted (Para. 19, Page 5). Tightening the bill acceptance criteria as taught by '487 would result in fewer potentially fraudulent bills being accepted and tallied by the system of '627. This modification would thus have a prophylactic advantage of reducing the likelihood casino personnel would be summoned to service the machine and would result in fewer interruptions of game play.

Response to Arguments

2. Applicant's arguments with respect to claims 19 to 25 and 27 have been considered but are moot in view of the new ground(s) of rejection. The applicant's remarks pertain to the previous references not pertaining to a sequentially repeating set

of first, second, and third patterns. The examiner points the applicant to '627, which in the background description of the prior art teaches an annunciator having an array of illuminating elements configured to be illuminated in first, second, and third illuminating patterns, the first illuminating pattern being different from the second illuminating pattern, the second illuminating pattern being different from the third illuminating pattern, and the first pattern being different from the third illuminating pattern (Para. 4, runway sequence pointing to place bill into slot, disclosed without further elaboration; sequenced runway pattern known in the art as having different respective and sequentially flashed first, second, and third patterns, as evidenced by Chase, 4,291,294 A, Fig. 3, 22, 5:59-6:10). It would have been obvious a minor modification to have applied the sequential first, second, and third patterns of '627's background to '627's main embodiment. Fig. 3 of '627 indicates pointers indicating the direction in which the bill is intended to be inserted into the bill slot. The arrows are arranged in rows pointing toward the slot. These rows of arrows could be easily modified by one of ordinary skill in the art to flash in the sequential runway manner indicated. This would clearly indicate to the player the direction in which bills are to be inserted into the slot. The examiner respectfully disagrees with the applicant as to the claims' condition for allowance.

Citation of Pertinent Prior Art

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chase in U.S. patent 4,291,294 A teaches a sequentially flash runway indication (comprising at least a first pattern, a second pattern, and a third

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pattern, flashed in that respective order, Fig. 3, 22, extending from 2500 ft. to 1000 ft., 5:59-6:10).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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